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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,404	07/09/2003	Ernst Gorenflo	3663-37	4016

7590 03/27/2006

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EXAMINER

PAYER, HWEI SIU CHOU

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/617,404

Applicant(s)

GORENFLO ET AL.

Examiner

Hwei-Siu C. Payer

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-9,11,13-16,18 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-9,11,13-16,18 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2004 and 07 September 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

The amendment filed on 9-7-2005 has been entered. The allowable subject matter of claim 17 as indicated in the final rejection has been withdrawn. Any inconvenience to the Applicant is regretted.

Drawings Objection

1. The drawings are objected to because

(1) Figs.2 and 4 as amended (filed on 11-16-2004) is objected to because it does not comply with 37 C.F.R. 1.121. Specifically, the replacement drawing sheets must be identified on the top margin as "Replacement Sheet" and show the desired changes without markings.

(2) The new drawings sheet containing Figs.5-7 (filed on 9-7-2005) must be identified on the top margin as "New Sheet".

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the vibration-reducing element including a threaded adjusting element and a hollow damping element (cited in claim 1), the flexible body (cited in claim 8) and the spring element (cited in claim 9) must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Objection to the Specification

The disclosure is objected to because of the following informalities:

In the paragraph as amended on 9-7-2005, at lines 3 and 6, reference numerals "32" and "48" are not found in the drawings.

Appropriate correction is required.

Claims Objection

Claims 14, 16, 18, 20 and 21 are objected to because of the following informality:

(1) Claim 14 should end with a period.

(2) In claims 16 and 18, line 2, "damping elements" should read --damping element-- (note line 10 of claim 1). Also, "are" (at line 2 of claim 16) and "have" (at line 2 of claim 18) should read --is-- and --has--, respectively.

(3) In claims 20 and 21, "damper" should read --damping element--.

Appropriate correction is required.

Claims Rejection - 35 U.S.C. 112, first paragraph

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 4-9, 11, 13-16, 18 and 20-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(1) Claim 1 as amended calls for the vibration-reducing element (18) including a threaded adjusting element (44, see Fig.4) and a hollow damping element (22, see Figs.5-6). As disclosed (see page 6, lines 1-4), the vibration-reducing elements 18 are

either in the form of a spring element 20 (see Fig.4) or a damping element 22 (see Figs.5-7) or the combination of a spring element and a damping element (not shown in the drawings). However, there is no disclosure of a spring element (20) and a damping element (22) that is workable together with the spring element (20) to reduce vibration. It is not understood how the spring element (20) of Fig.4 is workable with the damping element (22) of Figs.5-7.

(2) It is not clear how the damping constant can be adjusted by means of an axial prestress in solid dampers or by means of rotatable eccentric rings arranged in the hollow dampers. Further, it is not clear how the adjustment of the damping element 22 can be achieved by filling the hollow damper with compressed air or a fluid.

Claims Rejection - 35 U.S.C. 112, second paragraph

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 4-9, 11, 13-16, 18 and 20-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) In claim 1, the term "vibration-reducing spring element" is misleading. As disclosed (see page 6, lines 1-4), the vibration-reducing elements 18 are either in the form of a spring element 20 (see Fig.4) or a damping element 22 (see Figs.5-7) or the combination of a spring element and a damping element (not shown in the drawings).

It appears the Applicant intends to claim the vibration-reducing element (18) as a combination of spring element (20) and a damping element (22). The vibration-reducing element should not be called "vibration-reducing spring element" (as at line 5 of the claim). The term should simply refer to --vibration-reducing element (18) having a spring element (20)--. Also, "said at least one vibration-reducing spring element (18)" (at line 8 of the claim) should read --said sprig element (20)--, and "vibration-reducing spring element" (at line 9 of the claim) should read --vibration-reducing element--. Claims 4-6, 8, 11, 13-15 and 22 should be amended accordingly.

(2) Claims 4 and 5 are vague and indefinite. It is not clear what structure of the vibration-reducing element is being claimed therein. Further, "the spring wire", "the average winding diameter" and "the spring length" have no clear antecedent basis.

(3) The scope of claim 7 is vague. As the disclosed invention is understood, the threaded adjustment element cited in claim 1 is indeed the adjusting screw 44 of claim 7 which in term is the rigid body of claim 6. It appears the threaded adjustment element, the rigid body and the adjusting screw all refer to the same element (i.e. the screw 44 shown in Fig.4).

(4) Claims 13, 14 and 15 are vague and indefinite. It is not understood exactly what structure of the implement is being claimed therein. Further, it is not clear how the average winding diameter and the sprint wire thickness are defined.

(5) Claim 16 contradicts claim 1. As the disclosed invention is understood (see lines 21-22 on page 7 of the specification), the damping element 22 may be in the form

of solid dampers or hollow dampers. Since claim 1 calls for a hollow damping element, the damping element cannot be solid dampers, too.

Claims Rejection - 35 U.S.C. 102(b)

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4-9, 11, 13-16, 18, 20, 22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Taomo (U.S. Patent No. 5,447,295).

Taomo's vibration-reducing element (Fig.2) comprises a spring steel wire element (10) and a threaded adjusting element (40) in communication therewith. While not explicitly stated, it is inherent the spring constant of Taomo's spring element (10) can be adjusted by tightening or loosening the threaded adjusting element (40). Further, Taomo's rubber element (30) is considered as a hollow damping element that is filled with gas (i.e. air) as claimed. A resilient flexible body (20) can be screwed into the spring element (10), and a contact surface (22) is arranged inside the spring element (10) as claimed.

Claim Rejection - 35 U.S.C. 103(a)

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taomo (U.S. Patent No. 5,447,295).

Taomo's handheld implement as set forth shows all the claimed structure except the hollow damping element (30) is made of rubber rather than plastic.

The claimed plastic damping element is not patentably distinct over Taomo's rubber damping element, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Indication of Allowable Subject Matter

Claim 21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Remarks

Applicant argues, at page 8 of the amendment, the flexible body cited in claim 8 refers to element 54 in Fig.4. Examiner disagrees. First of all, element 54 shown in Fig.4 is a screw-type element, and it has not been described in the original specification as being a "flexible" element. Further, claim 9 further defines the flexible body being a spring element which contradicts the screw-type element 54 of Fig.4.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 571-272-4511. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for official communications and 571-273-4511 for proposed amendments.

H Payer
March 21, 2006



Hwei-Siu Payer
Primary Examiner